Remarks

Status of the Claims

Claims 1-29 and 31-41 were pending in the application. All claims were finally rejected in the Office Action mailed February 6, 2007. By this paper, claims 1, 3, 4, 21-24, 25, 27, 28, and 41 have been amended, claim 2 has been canceled, and new claims 42-51 have been added. For the reasons set forth below, Applicants submit that each of the pending claims is patentably distinct from the cited prior art and in condition for allowance. Reconsideration of the claims is therefore respectfully requested.

Claim Rejections – 35 U.S.C. 103(a)

Claims 1 and 41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Logan. Claims 2, 4, 11, and 16-19 were rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Logan and in further view of Vallone. Claims 3 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Logan and further in view of Abecassis. Claim 7 was rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Logan in view of Voyticky. Claim 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Logan and in further view of Abecassis and Novak. Claims 21, 25-26, 32, 35, and 40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Logan and further in view of Hayward. Claims 22, 24, 31, and 36-39 were rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Logan and in further view of Hayward and Vallone. Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over

Milewski in view of Logan, Hayward, Vallone, and Abecassis. Claim 27 was rejected under 35 U.S.C. 103(a) as being unpatentable over Milewski in view of Logan and in further view of Hayward and Voyticky. These rejections are respectfully traversed.

1. Milewsky teaches away from two locally stored copies of a media program.

As amended, claim 1 recites a method for distributing personalized editions of media programs, comprising:

> accessing a ***first locally stored copy*** of a media program ***at an editing device***;
>
> ...
>
> transmitting the sequence of bookmarks from the editing device to a ***playback device having access to a second locally stored copy*** of the media program, ...

As described at pages 17 and 20 of the specification, both the editing and playback devices have their own locally stored "copies" of the media program. For instance, the editing and playback devices may each have a DVD containing the media program. Alternatively, the editing and playback devices may each create a recording of the media program from a broadcast medium. Having two locally stored copies may be advantageous, for example, when one or both of the editing and playback devices do not have persistent network connections. Additionally, Milewski's system, as explained below, would be completely disabled in the event of a network interruption, whereas the claimed invention would still be able to function.

Unlike the claimed invention, Milewski teaches archiving programs on a central network server (see server 120 in FIG. 1) for future access by a user. Col. 1, lines 64-65. The server 120 segments the archived programs into discrete portions and

associates a unique universal resource locator (URL) with each discrete portion. Col. 5, lines 28-30. The viewer can communicate to the server 120 the identity of the viewer, the identity of a program of interest to the viewer, and a particular time of interest during the program. Col. 3, lines 10-14. The network server 120 then transmits the corresponding URL to the user's personal computer (PC) 150 or to a personalized web page. Col. 6, lines 12-16. The same user that identified the particular time of the program of interest can then bookmark the URL for future access to the particular portion of the archived program without requiring the user to search the server 120. Col. 6, lines 18-23.

Milewsky specifically ***teaches away*** from the claimed invention by requiring that "***in order to practice the present invention***, the network news program, as well as being broadcast for viewing, ***must*** also be archived on a network for future access by the viewer." Col. 1, lines 62-65. Since the essence of Milewsky is archiving a single copy of the program on a central network server, Applicant respectfully submits that the purpose of Mllewsky would be frustrated by having multiple local copies of the media program as in the claimed invention, neither of which is archived on a network server.

2. Logan and the other references do not teach or suggest first and second locally stored copies of a media program.

Logan teaches that his system relates to "editing the content of a broadcast programming signal to provide a proprietary program signal that has been tailored to the preferences of an individual ***monitoring*** the broadcast programming signal." Abstract (emphasis added). Logan further teaches that the monitor 42 (used by the editing station 42) includes an "RF tuner for ***receiving the broadcast programming signal***,"

and that the "monitor 44 can further include a video display element that can display to an operator at the editing station 42 the television program ***being broadcast***." Col. 6, lines 58-63. In other words, a person at the editing station 42 monitors (watches) a television program being received in real time and indicates start and stop times for use in generating a marking signal. See col. 6, lines 16-21, col. 7, lines 5-55. It is clear, therefore, that the editing station 42 does store a local copy of the media program, as claimed, but, rather, displays a live presentation of the television program on the monitor 44.

The other references also do not teach or suggest first and second locally stored copies of a media program. For example, Vallone simply relates to a set of bookmarks within a single DVR device. There is no teaching or suggestion of transmitting bookmarks between devices, as claimed.

A rejection based on prior art – whether grounded in anticipation or obviousness – must account for each and every claim limitation. *Celeritas Techs. Inc. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998) (anticipation); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q.2d 494, 496 (CCPA 1970) (obviousness); MPEP § 2143.03 ("To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.") (emphasis added). Because the foregoing limitations are not met, Applicants respectfully submits that a prima facie case of obviousness cannot be satisfied by the prior art of record.

3. The Office Action did not address the limitation of a "non-chronological" path.

Claim 41 recites a system for distributing personalized editions of media programs, comprising:

> means for transmitting the sequence of bookmarks defining the ***non-chronological path*** through the media program from the editing device to a playback device having access a second local copy of the media program, wherein the sequence of bookmarks is usable by the playback device to skip from one point of interest to another within the media program along the ***non-chronological path*** in response to a user command.

As described at page 21 of the specification, the sequence of bookmarks may be non-chronological. In other words, the "next" bookmark in a sequence may not be chronologically "later" within the media program. This allows the personalized path to start at the point of greatest interest, which might be near the end of the media program, and thereafter proceed to points of interest near the beginning of the media program.

Applicants respectfully submit that the cited references do not disclose or suggest a sequence of bookmarks defining a ***non-chronological path through the media program***. Applicants respectfully request that the Examiner clarify the Office's position on how this limitation is taught in claim 41. New claim 42 has been added, which is essentially a method version of claim 41.

4. The cited references do not teach transmitting a sequence of bookmarks representing a personalized path of "skip-to" points through the media program from an editing device to a "different" playback device.

As amended, claim 1 recites:

> generating a sequence of ***bookmarks defining a personalized path of skip-to points through the media***

program, each bookmark defining one of the designated points of interest within the media program; and

transmitting the sequence of bookmarks from the editing device to a playback device having access to a second locally stored copy of the media program, the second locally stored copy being obtained from a source other than the editing device, wherein the sequence of bookmarks is usable by the playback device to allow a user to skip, in response to a user command, to a next point of interest within the media program according to the sequence defined by the personalized path.

Milewski

Milewski is silent as to transmitting bookmarks that define a ***personalized path of skip-to points through the media program***. Milewski does not disclose or suggest a "sequence of bookmarks," much less a sequence of bookmarks representing a "personalized path of skip-to points." Milewski does not even disclose transmitting bookmarks from an editing device to a different playback device. In Milewski, the user's PC is used to designate the particular time of interest and is therefore the "editing device." However, the user's PC is also the device used to retrieve a bookmarked segment from the archive server, and is also therefore the "playback device," contradicting the limitation of a "different" playback device.

Logan

Logan also is silent with respect to transmitting a sequence of bookmarks representing a personalized path of "skip-to" points through the media program from an editing device to a "different" playback device. According to Logan:

> In one embodiment, the operator enters a sequence that denotes the beginning of ***the portion of the compressed broadcast programming signal to be deleted***. ... At a subsequent time, the operator enters a stop sequence that is detected by the editing station 42. Similarly, the editing station 42 reads the time stamp generated by the time stamp 48 and stores a stop signal in the editing station memory. The editing station 42 then generates, as a function of the start signal and stop signal, a marking signal that represents as a function of the time stamps, ***that portion of the broadcast programming signal that is to be deleted***. The editing station 42 can transmit via the communication system 40 the marking signal to the communication signal [*sic,* system] 38. The processor 34 can receive from the communication system 38 the marking signal. The processor 34 can determine the start time of ***the portion of the broadcast programming signal to be deleted*** and can operate the memory system 18 to search for a time stamp proximate to the time stamp of the start time represented in the marking signal. The ***processor 34 can then delete*** that portion of the stored compressed programming signal that is associated with time stamps having values between the start and stop times of the marking signal.

Col. 7, lines 11-37 (emphasis added).

As is clear from the foregoing, Logan does ***not*** transmit a sequence of bookmarks representing a personalized path of ***skip-to*** points through the media program, as claimed. Rather, Logan communicates a marking signal used to ***delete*** a portion of the broadcast signal stored in the memory system 18. The claimed skip-to points allow a user to skip to points of interest within the media program. However, a

user may **choose** to watch the entire media program or only take advantage of certain skip-to points.

The claimed invention places the user of the playback device in control to decide what to view and what to skip. By contrast, Logan ***teaches away*** from giving control to the user of the playback device. For example, Logan's abstract teaches that "editing the content of a broadcast programming signal to provide a proprietary program signal **that has been tailored to the preferences of an individual monitoring the broadcast programming signal** [*i.e.*, the user of the editing device]. The user of Logan's playback device has no control, since the whole point of Logan's system is to "***delete*** that portion of the stored compressed programming signal that is associated with time stamps having values between the start and stop times of the marking signal," which is selected by the user of the editing device. Col. 7, lines 36-37.

Vallone

Vallone is also silent about the claimed limitation of transmitting a sequence of bookmarks representing a personalized path of "skip-to" points through the media program from an editing device to a "different" playback device. With respect to bookmarking, Vallone simply states that the user may set one or more bookmarks, and that the bookmarks may be displayed on the trick play bar. Col. 16, lines 33-36; col. 21, lines 11-12. The user can sequentially jump to each bookmark indicator by pressing the jump button on the remote control. Col. 21, lines 15-17.

However, Vallone does not teach or suggest the "transmission" of bookmarks, much less a sequence of bookmarks, from an editing device to a different playback

device. Indeed, the editing device and the playback device are, in Vallone, the same devices.

5. The cited references do not teach or suggest starting presentation of the media program at a position marked by a previous bookmark in response to a "skip-backward" command.

Claim 4 recites "starting presentation of the media program at a position marked by a previous bookmark in the sequence in response to a skip-backward command received at the playback device." While Vallone teaches that a user may access any of the user's bookmarks, Vallone is silent about a "skip-backward" command for accessing a previous bookmark in a sequence. Vallone discloses a single "jump button 1414." Col. 16, line 55 (see also FIG. 14). Applicant respectfully notes that the markings on the button suggest a forward jump ("->|"). None of the other buttons on the remote control of FIG. 14 suggest skipping to an earlier bookmark. For example, the rewind and fast forward buttons 1407, 1408 control the direction and speed of playback, while the instant replay button 1415 is for skipping backward a fixed period of time (*e.g.*, 10 seconds). Col. 20, lines 22-30. None of the buttons on Vallone's remote control permit "skipping backward" through a sequence of bookmarks. Col. 21, lines 15-17. Most certainly, none of the references teach or suggest both a skip-forward and a skip-backward button.

6. The cited references do not teach or suggest that a bookmark contains supplemental information that is presented with the media program.

New claim 43 recites:

generating a sequence of bookmarks defining a personalized path through the media program, each bookmark representing one of the designated points of interest within the media program, ***at least one bookmark including supplemental information to be presented with the media program***.

As described at page 19 of the specification, bookmarks may include additional information, such as commentary by a user of the editing device 402. The additional information may be in the form of text, a hyperlink, an image, audio, or video. In one configuration, the additional information may be overlaid upon the media program, for example, as pop-up text or in a picture-in-picture configuration. Applicants respectfully submit that none of the cited references teach or suggest storing supplemental information, such as a video commentary, in a bookmark.

Conclusion

For at least the foregoing reasons, the cited prior art references, whether considered individually or in combination, fail to disclose each of the limitations in any of the pending independent claims. For at least the same reasons, each of the claims depending therefrom are also patentably distinct from the cited prior art.

In view of the foregoing, all pending claims represent patentable subject matter. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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